

Second Amendment With RCE
U.S. Patent Application Serial No. 10/039,565
Office Action Dated: May 23, 2005
Inventor: Andrew Mark Stringer
Attorney Docket No. 41759-57619

REMARKS

This Amendment is filed in response to the Office Action dated December 20, 2005 along with a one (1) month extension of time and a Request for Continued Examination ("RCE").

Summary of Examiner's Interview:

There was a telephonic interview with Examiner Neutrauter and Applicant's Attorney on March 20, 2006. Applicant proposed that the term "commercial value" be replaced with the term "monetary worth." This monetary worth is updated to reflect the "... added monetary worth of the electronic data in the data packet associated with the action of forwarding the data packet." Examiner Neutrauter seemed positive with the amendment of this term, however, recommended the filing of a Request for Continued Examination ("RCE") since this amendment does more than just cancelling claims or attending to formalities. Therefore, the Examiner believed that the proposed amendment that amended the term "commercial value" would not be appropriate for a response after a final rejection and may require an additional search. Examiner Neutrauter also indicated that the Farley Article dated 2001 and the "General Packet Radio Service" Article may be pertinent. As provided below directly from the United

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States Patent Office's website in Public PAIR, the priority date for this patent application is June 22, 1999.

Foreign Priority		
Country	Priority	Priority Date
	PCT/GB00/02413	06-21-2000
UNITED KINGDOM	9914418.0	06-22-1999

Therefore, these two publications were published after the priority date of the present patent application and cannot be considered prior art. A formal interview summary is enclosed in the Appendix.

Rejections Under 35 U.S.C. Section 103(a):

Claims 1 and 8 were rejected under 35 U.S.C. Section 103 as being unpatentable over Naik. Claims 1 and 8 are amended to recite a "... data packet sent from the server to have associated with it a data field containing a value which represents a **monetary worth of the electronic data in the data packet, ...**" and **"... to update the value contained in the data field to reflect the added monetary worth of the electronic data in the data packet associated with the action of forwarding the data packet."**

Support for this amendment can be found in Paragraph [0043], Lines 2-3 of Applicant's Published Patent Application as: "This piece of information and the service

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of providing it both have some inherent worth and this worth can be enumerated and written in the value field of the packet". Moreover, Paragraph [0050], Lines 8-15 of Applicant's Published Patent Application recites: "There is a potential problem here, unless the exchange value of an NCU is pegged to some hard currency. Otherwise, it will float erratically as the number of NCU's per network transaction can vary inversely with the exchange rate to hard currency, without changing the **actual monetary worth** of the network transaction." Also, Applicant's Published Patent Application recites in Paragraph [0024], Lines 1-8 as: "Preferably the electronic data is transmitted in the form of packets. Preferably the part of the network has an associated data processor which reads the value in the data field associated with an incoming data packet received by the part of the network, calculates a new value based on the read value and the cost of forwarding the data packet, and forwards the data packet with the new value in the associated data field." Therefore, no new matter has been added.

Naik is a general purpose reference document on standards and protocols dating from around 1998. Naik makes a number of references to the IETF's (Internet Engineering Task Force) RFC (Request For Comments) Documents (Page 37, First Paragraph, Page 40, First Paragraph) when further or complete details are required. In fact, Naik is simply an explanation of many of the protocols implemented by the RFC documents.

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The "Time to Live" (TTL) field is a "hop count" that decrements downward based on the number of nodes visited by a data packet so that "... a packet is discarded when the counter hits zero" (Naik, Page 39, Lines 1-3). This is the exact opposite of an added monetary worth that increases with the forwarding of the data packet. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In this case, the "TTL" field disclosed in Naik completely discredits and discourages the Applicant's Invention by going in the opposite direction and decreasing the value of the data field in the header rather than providing a value in the header for added monetary worth. In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365,

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1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). In this case, the use of a decreasing "hop count" to dispose of old data packets disclosed in Naik would not render the Applicant's Invention obvious where **the monetary worth of the electronic data in the data packet is in a data field with the provision of an added monetary worth of the electronic data in the data packet associated with the action of forwarding the data packet.**

Therefore, it is respectfully believed that the term "monetary worth" is definite and defined and the added monetary worth with the forwarding of the data packet provides a functional relationship to the remainder of the claim in both Claims 1 and 8, which is respectfully believed to fully address the comments made by the Examiner in the Office Action.

As previously stated in the Interview Summary, the priority date of the present patent application is June 22, 1999. This predates the "General Packet Radio Service" reference as well as the Farley Article. It is respectfully believed that the Article "RFC 1598" does not appear to provide any hint or suggestion regarding data packet charging.

Although Naik suggests that a data field may be used for containing any data, it does not disclose the use of a data field for measuring the monetary worth of the electronic data in the data packet. Moreover, it does not disclose the feature, now

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introduced into Claims 1 and 8, in which, as the data packet is transferred across the computer network, the monetary worth data field is updated to reflect the value added by the forwarding of the data. In other words, at each step in the process, the enhanced monetary worth of the data is determined. Hence, the monetary worth, which can include both the cost of providing the information and the cost of transporting the information can both be enumerated and accrued in the same data field.

It is well established in U.S. Patent Law as well as the Manual for Patent Examining Procedure (M.P.E.P.) Section 2143.03 that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). In this case, the use of a data field which represents a monetary worth of the electronic data in the data packet and is updated to reflect a corresponding added monetary worth of the electronic data in the data packet associated with the action of forwarding the data packet is not disclosed in Naik or any other cited prior art.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the

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combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). In this situation, there is absolutely no suggestion regarding the utilization of a monetary worth in a data field that is augmented and updated with the forwarding of the data packet with a reference to a "hop count" that decrements to zero shown in Naik.

Therefore, it is respectfully believed that Claims 1 and 8 overcome the rejection under 35 U.S.C. Section 103 and are patentable over Naik and are in condition for allowance.

Claims 3-6 and Claims 9 and 12-15 are also rejected under 35 U.S.C. Section 103 over Naik. Claims 2, 10, and 11 were previously cancelled and it is respectfully believed that this rejection with regard to these Claims is rendered moot. Claims 3-6 and Claims 12-15 depend from Claim 1 and Claim 9 depends from Claim 8. If an independent claim is nonobvious under 35 U.S.C. Section 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Therefore, Claims 3-6 and Claims 9 and 12-15 overcome the rejection under 35 U.S.C. Section 103 and are in condition for allowance.

Claim 7 was rejected under 35 U.S.C. Section 103 as being unpatentable over Naik and further in view of Saari et al. (U.S. Patent No. 6,338,046). Since Claim 7 depends from Claim 1, as amended, and contains each and every limitation thereof. If an independent claim is nonobvious under 35 U.S.C. Section 103, then any claim

depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Also, it is respectfully believed to be axiomatic, that a feature not disclosed in either of two cited references cannot come into being by their combination. In this case, the use of a data field which represents a monetary worth of the electronic data in the data packet and is updated to reflect a corresponding added monetary worth of the electronic data in the data packet associated with the action of forwarding the data packet is not disclosed in either Naik or Saari et al. For example, Saari et al. discloses in Column 2, Lines 1-19: "The present invention is directed to a system and method for charging for usage of network service connections. The network includes a number of nodes which facilitate the transfer of information from a source location to a destination location. At the time a connection is established with a node, **a billing message or cell is transmitted to the node over the connection.** The billing cell contains billing and connection information which is copied by the node and used to produce billing information. **Information cells are transmitted over the same connection subsequent to the transmission of the billing cell.** A terminate billing cell or conventional means may be used to drop the connection when the connection is no longer needed. The node computes the cost of using the connection based on the billing and connection information copied from the billing cell. The connection usage computation may also take into account other factors, such as the connection time and

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the amount of data transferred over the connection." Therefore, there is a separate transmission of billing and information and Saari et al. does not disclose the provision of monetary worth in the data packet itself nor the augmentation in monetary worth but the generation of a separate electronic transaction regarding billing and a separate electronic transaction regarding information.

Therefore, it is respectfully believed that Claim 7 overcomes the rejection under 35 U.S.C. Section 103 and is patentable over Naik in view of Saari et al. and is in condition for allowance.

Therefore, Applicant respectfully requests favorable consideration and allowance of this patent application, as currently amended. If a telephone interview would facilitate this matter, the Examiner is invited to contact the undersigned.

Respectfully submitted,

Thompson Coburn LLP

By: 

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Dated: April 18, 2006

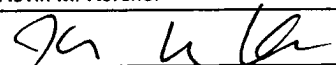
Request for Continued Examination (RCE) TRANSMITTAL Address to: Mail Stop RCE Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	10/039,565
	Filing Date	August 30, 2002
	First Named Inventor	Andrew Mark Stringer
	Art Unit	2143
	Examiner Name	George C. Neutrauter
	Attorney Docket Number	41759-57619

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application. Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).
- a. ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.
- i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____
- ii. ☐ Other _____
- b. ☒ Enclosed
- i. ☒ Second Amendment
- ii. ☒ Petition for Extension of Time
- iii. ☐ Information Disclosure Statement (IDS)
- iv. ☐ Other _____
2. **Miscellaneous**
- a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)
- b. ☐ Other _____
3. **Fees** The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.
- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. 20-0823
- i. ☒ RCE fee of \$395.00 required under 37 CFR 1.17(e)
- ii. ☒ Extension of time fee (37 CFR 1.136 and 1.17)
- iii. ☐ Other _____
- b. ☐ Check in the amount of \$ _____ enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

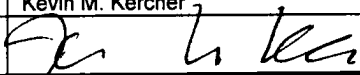
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print/Type)	Kevin M. Kercher	Registration No. (Attorney/Agent)	33,408
Signature		Date	April 18, 2006

CERTIFICATE OF ELECTRONIC TRANSMISSION

I certify that the documents referred to as enclosed herein are being transmitted to the U.S. Patent and Trademark Office via the EFS Web system located on the USPTO website on April 18, 2006.

Name (Print/Type)	Kevin M. Kercher	Date	April 18, 2006
Signature			

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a) FY 2005		Docket Number (Optional) 41759-57619	
<i>(Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).)</i>			
Application Number 10/039,565		Filed August 30, 2002	
For Computer Network Payment System			
Art Unit 2143		Examiner George C. Neutrauter	

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.

The requested extension and fee are as follows (check time period desired and enter the appropriate fee below):

	<u>Fee</u>	<u>Small Entity Fee</u>	
<input checked="" type="checkbox"/> One month (37 CFR 1.17(a)(1))	\$120	\$60	\$ <u>60.00</u>
<input type="checkbox"/> Two months (37 CFR 1.17(a)(2))	\$450	\$225	\$ _____
<input type="checkbox"/> Three months (37 CFR 1.17(a)(3))	\$1020	\$510	\$ _____
<input type="checkbox"/> Four months (37 CFR 1.17(a)(4))	\$1590	\$795	\$ _____
<input type="checkbox"/> Five months (37 CFR 1.17(a)(5))	\$2160	\$1080	\$ _____

☒ Applicant claims small entity status. See 37 CFR 1.27.

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 20-0823. I have enclosed a duplicate copy of this sheet.

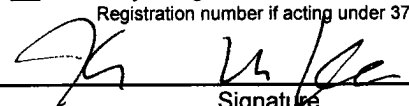
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the ☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).

☒ attorney or agent of record. Registration Number 33,408

☐ attorney or agent under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



 Signature

April 18, 2006

 Date

Kevin M. Kercher

 Typed or printed name

314-552-6345

 Telephone Number

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ Total of 1 forms are submitted.

This collection of information is required by 37 CFR 1.136(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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